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No. 77-667

In the Supreme Court of the United States

OCTOBER TERM, 1977

GAYETTA BARKER, EXECUTRIX OF THE ESTATE OF FRANK S. BARKER and WILLIS G. PEHL, PETITIONER'S

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS and TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

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Petitioners seek review of the judgment of the United States Court of Customs and Patent Appeals affirming the rejection of petitioners' patent claim.

Petitioners applied for a patent based upon "a method claim reciting four steps in a process of making substantially uniform regular modular prefabricated shingle panels" (Pet. App. A-2). This claim (Claim 18) was made in an amendment to an earlier application which in turn was supported by specifications describing the invention (Pet. App. C-1 to C-6). By its terms, Claim 18 stated a specific relationship between the number of shingles and the size and length of the backing board by including a step of "selecting elongated backing boards

* * * each backing board having a length at least as great as the aggregate width of at least six shingles" (Pet. App. A-1).

The Patent and Trademark Office Board of Appeals rejected petitioners' claim in an original decision (Pet. App. A-1 to A-5) and on reconsideration (Pet. App. B-1 to B-9), on the separate grounds that the claim did not satisfy the "written description" requirement of 35 U.S.C. (Supp. V) 112,[1] and that the application contained "new matter" inserted by amendment in violation of 35 U.S.C. 132.[2] Although petitioners purported to claim a four step panel construction method, the Board "fail[ed] to find in the specification a written description of these method steps" (Pet. App. A-2). The Board rejected petitioners' argument "that the 'description' requirement is satisfied if

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[1]35 U.S.C. (Supp. V) 112 provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[2]35 U.S.C. 132 provides:

> Whenever, on examination, any claim for patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

one of ordinary skill in the art, after reading the specification, could conjure up the specific steps recited in this claim" (*ibid.*).

The Board found that the backing board length limitation of "at least six shingles" that appeared for the first time in Claim 18 was new matter. The Board "searched the specification and drawings in vain for a disclosure that the backing board's length must be at least six shingle widths" (Pet. App. A-3).

The United States Court of Customs and Patent Appeals (two judges dissenting) affirmed the rejections of Claim 18 both "under the description requirement of the first paragraph of 35 USC 112 and for new matter under 35 USC 132" (Pet. App. C-19).[3]

1. Petitioners' sole contention (Pet. 6-26) is that the Court of Customs and Patent Appeals incorrectly interpreted the patent description requirement of 35 U.S.C. (Supp. V) 112. The statute requires that the specification "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art * * * to make and use the same * * *" (*supra*, p. 2, n. 1). Petitioners argue (Pet. 12) that this provision is satisfied as long as the specification contains a "description that enables one

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[3]Judge Rich, concurring, found it unnecessary to decide whether petitioners' specifications contained a sufficient written description of the invention, although he did acknowledge that description and enablement "are distinct though commingled requirements" (Pet. App. C-23). Judge Rich also agreed that petitioners' claim contained new matter made by amendment, in violation of 35 U.S.C. 132 (Pet. App. C-21).

skilled in the art to make and use the invention," and that it does not also require a separate description of the invention.

On its face, however, Section 112 imposes two requirements: (1) that there be a "description" of the invention and of the manner and process of making and using it, and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention. As the plurality opinion below here stated "[t]he words are of ancient lineage * * * preserved, in writing the Patent Act of 1952, because they were familiar and had many times been construed" (Pet. App. C-22). Furthermore, as that opinion pointed out, "[c]ommencing with our first patent statute, there have been separate requirements for a description of the invention and a description of how to make and use it" (Pet. App. C-12). See *Evans* v. *Eaton*, 7 Wheat. 356, 433.

Since there is no compelling indication that Congress intended to alter the traditional statutory requirements in enacting the successive patent statutes (see Pet. App. C-12 to C-17), the Court of Customs and Patent Appeals has continued to recognize that "there is a description of the invention requirement in 35 USC 112, first paragraph, separate and distinct from the enablement requirement. *In re Bowen*, 492 F. 2d 859, 864, 181 USPQ 48, 52 (CCPA 1974); *In re Smith*, 481 F. 2d 910, 914-15, 178 USPQ 620, 623-25 (CCPA 1973); *In re Moore*, 58 CCPA 1042, 1047, 439 F. 2d 1232, 1235, 169 USPQ 236, 238-39 (1971)" (Pet. App. C-9).[4]

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[4]Judge Markey's dissenting opinion appears to acknowledge this line of authority, although he argues "it would have been better if the court had held, in certain past chemical cases, that whatever 'enablement' was present, it was not in 'full clear, concise and exact terms,' rather than to have created a 'separate description' gloss" (Pet. App. C-26). But see *Application of Mott*, 539 F. 2d 1291, (C.C.P.A.); *Application of Winkhaus*, 527 F. 2d 637, (C.C.P.A.). Judge Markey also disagreed with the majority on the factual issue whether the number of shingles was critical and was new matter prohibited by 35 U.S.C. 135 (Pet. App. C-27).

Petitioners make no claim that their application satisfied the separate "description" requirement of the statute. The decision in this case, which merely "reaffirm[s the court's] recognition that 35 USC 112, first paragraph, contains separate requirements" (Pet. App. C-16), does not warrant further review.

2. In any case, the Court of Customs and Patent Appeals also correctly held that Claim 18 is deficient because "the limitation 'at least six shingles' in the claim is not supported by the description of the invention in the specification or drawings and * * * constitutes new matter" in violation of 35 U.S.C. 132 (Pet. App. C-19). Although "some criticality" exists in the length of the backing board (Pet. App. A-3), petitioners did not claim a new method of constructing panels of a six-shingle width in their original specifications; that limitation appeared for the first time in Claim 18 (Pet. App. C-19). But Claim 18 "was introduced by an amendment" (Pet. App. C-5), and 35 U.S.C. 132 provides that "[n]o amendment shall introduce new matter into the disclosure of the invention." Thus, as Judge Miller stated, concurring, "the basic problem here is simple: new matter in violation of 35 USC 132, was inserted by amendment and the claim contains that new matter" (Pet. App. C-21). Petitioner does not challenge and the record (Pet. App. A-3 to A-4) amply supports this factual determination, which independently supports the judgment below.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

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